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In re Application of HAMMOND et al
U.S. Application No.: 09/807,608
Int. Application No.: PCT/AU99/00891
Int. Filing Date: 15 October 1999
Priority Date: 16 October 1998
Attorney Docket No.: Q63675
For: A PARKING MANAGEMENT SYSTEM

DECISION ON PETITION

UNDER 37 CFR 1.47(a)

This is in response to applicants' "Petition Under 37 C.F.R. §1.47(a) and Submission of Executed Declaration, Added Pages and Declaration of Facts in Response to the Notification of Missing Requirements" filed 26 December 2001, requesting that the present application be accepted for United States national stage processing without the signature of one of the four joint inventors.

BACKGROUND

On 15 October 1999, applicants filed international application PCT/AU99/00891, which claimed priority of an earlier Australia application filed 16 October 1998. A copy of the international application was communicated to the USPTO from the International Bureau on 27 April 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 11 May 2000, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 16 April 2001.

On 16 April 2001, applicants filed national stage papers with the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 23 July 2001, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed along with a surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty (30) months from the priority date.

On 26 December 2001, applicants filed the present petition along with a declaration executed by three of the joint inventors and not executed by inventor Andrew Gockel.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, applicants have submitted a declaration signed by Jack Hammond, Michael Craig, and Arthur Hallett, each on his own behalf and on behalf of the nonsigning inventor Gockel.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

In the present case, applicants have not sufficiently established that a bona fide attempt was made to present a complete copy of the application papers (including specification, claims, drawings, and oath/declaration) to Gockel for signature. Although the affidavit of Michael Craig states that application papers were sent to Gockel on 11 September 2001 (see Craig's affidavit, pp.2-3), there is no evidence (e.g. a delivery confirmation receipt) that Gockel or his attorney actually received the communication. Furthermore, no details of any attempts to contact Gockel or his attorney by telephone to confirm receipt of the 11 September 2001 letter have been provided. Moreover, although the 11 September 2001 letter and Craig's affidavit state that the specification and declaration were sent to Gockel, there is no evidence that the claims and drawings were ever sent to Gockel. Therefore, it would be unreasonable to conclude at the present time that Gockel refuses to join in the application.

With regard to item (3) above, applicants have provided the requisite petition fee.


With regard to item (4) above, the petition states the last known address of the nonsigning inventor.

CONCLUSION

Because applicants have failed to satisfy item (2) above, the petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time are available under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.


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